

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
	:	Examiner: Victor S. Chang
YOUNGER AHLUWALIA et al.)	
	:	Group Art Unit: 1794
Application No.: 10/766,649)	
	:	Confirmation No.: 4007
Filed: January 27, 2004)	
	:	
For: COMPOSITE MATERIALS)	

November 26, 2008

Mail Stop: **Amendment**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

STATEMENT OF SUBSTANCE OF INTERVIEW AND
REQUEST FOR RECONSIDERATION

Sir:

Applicants appreciate the time extended by the Examiner on at least July 29, 2008 and November 19, 2008 to discuss the finality of the Office Action of April 29, 2008. During those conversations, the Examiner agreed that the finality of the Office Action of April 29, 2008 was improper. Accordingly, Applicants respectfully request that the Examiner re-open prosecution, vacate the Office Action of April 29, 2008, and issue a new Non-Final Office Action such that Applicants are afforded a full and fair opportunity to respond to the Office's new rejection rationale.

Applicants point to MPEP § 706.07 which states that "[t]he examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal." Since, under 37 C.F.R. §1.113(c), the Notice of Appeal of September 26, 2008 was a

proper reply to the Office Action of April 29, 2008, the Examiner can re-open prosecution by withdrawing the finality of the previous action. MPEP § 706.07(f)(III)(M).

For at least the following reasons, Applicants respectfully submit that the finality of the Office Action of April 29, 2008 was improper.

Foremost, the Examiner himself admits that the Office Action of April 29, 2008 includes a new grounds of rejection. *See* Office Action of April 29, page 2 (“In response to the amendments and arguments, upon a careful reconsideration, the grounds of rejection have been updated with a new interpretation of references of record as set forth below.”) and page 4 (“... applicants' arguments directed to the withdrawn reasoning in the prior grounds of rejection are moot.”). “Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).” MPEP § 706.07(a). In other words, at least one of two exceptions must exist for a second or subsequent office action to be made final when a new grounds of rejection is included that office action, either: 1) the grounds was necessitated by Applicants' amendment or 2) new art relied upon in the new grounds of rejection must have been cited in an IDS filed within the period set forth in 37 CFR 1.97(c).

Neither of those exceptions apply to the Office Action of April 29, 2008. The second exception clearly does not apply to the Office Action of April 29, 2008 because that Office Action does not rely on new art. As discussed below, the first exception also does not apply to the Office Action of April 29, 2008 because Applicants did not change the scope of the claims in the Amendment of February 19, 2008.

Applicants sole amendment to the claims in the Amendment of February 19, 2008 was adding an intended use recitation to the preamble of independent Claim 1. Particularly, the preamble of Claim 1 was amended to recite “A heat insulating and fire resistant composite

material comprising:” *See* Amendment of February 19, 2008, page 2 (underlining indicating the added recitation). Other than that intended use recitation, the claims were not amended after the Non-Final Office Action of October 19, 2007. Accordingly, Applicants’ Amendment of February 19, 2008 simply could not have necessitated the new grounds of rejection set forth in Office Action of April 29, 2008.

It is believed that this response represents a complete written statement as to the substance of the interview conducted on November 19, 2008, in accordance with M.P.E.P. § 713.04.

Applicants’ undersigned attorneys may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

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